

Remarks

Claims 1-6, 9-18 and 21-25 are currently pending in the patent application. For the reasons and arguments set forth below, Applicant respectfully submits that the claimed invention is allowable over the cited references.

In the instant final Office Action dated April 3, 2008, claims 1-2, 4-12, and 14-20 stand rejected under 35 U.S.C. § 102(e) over the Hwang reference (U.S. Patent No. 6,678,511); and claims 3 and 13 stand rejected under 35 U.S.C. § 103(a) over the Hwang reference in view of the Chan reference (U.S. Patent No. 6,920,471).

Applicant has amended independent claims 1 and 11 to incorporate limitations directed to the order of the filters and added new claims 21-25. Other minor amendments have been made to various dependent claims, such as to remove extraneous reference numerals and change “comprises” to “includes.” As such, Applicant respectfully requests that the Examiner enter these amendments as the application should now be in condition for allowance.

Applicant respectfully traverses the rejections under 35 U.S.C. § 102(e) over the Hwang reference for failing to show correspondence to limitations previously found in claims 8 and 18 and now found in independent claims 1 and 11. Neither the Final Office Action nor the Advisory Action has provided any explicit support for these rejections. The entire rejection for these limitations is merely a repeat of portions of the claims without any discussion thereof. As such, the rejections are improper on their face.

Notwithstanding and in an effort to facilitate prosecution, Applicant has reviewed the portions of the Hwang reference relied upon for other claim limitations and respectfully submits that these portions fail to teach correspondence to limitations directed to the orders of the filters differing by one. The cited portions of the Hwang reference appear to only explicitly mention nine filter stages in a first filter and two or four filter stages in a second filter. This is over twice as many stages between the two filters. Moreover, Applicant’s review revealed no suggestion that a difference of one between the orders of filters would be advantageous. Accordingly, the only teachings in the record that suggest using two filters that differ in order by one is Applicant’s specification, which offers many such examples and explanations regarding various potential advantages thereof. *See, e.g.*, Tables 1, 2 and 3 and the related discussions.

These tables show the unexpected results of using filters having orders that differ by exactly one. Accordingly, Applicant submits that the rejections cannot stand and respectfully requests that they be withdrawn.

Each of claims 2, 4-10, 12, 14-20 and 21-25 depend from one of claims 1 or 11 and therefore should also be deemed allowable. Applicant respectfully requests that the rejection under 35 U.S.C. § 102(e) be withdrawn.

Applicant respectfully traverses the rejections under 35 U.S.C. § 103(a) over the Hwang reference in view of the Chan reference for failing to provide a valid reason to combine the relied upon elements of each reference. This approach is contrary to the requirements of § 103 and relevant law. *See, e.g., KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (U.S. 2007)

Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.

In this instance, the Examiner erroneously asserts that one of skill in the art would modify the Hwang reference with the cited portions of the Chan reference in order to compensate for absolute sampling and digital delays. Applicant submits that such an argument relies upon circular logic. More specifically, the Examiner appears to assert that the reason the skilled artisan would add a digital filter is to remove delays associated with such a digital filter. In essence, the Examiner is improperly asserting that the skilled artisan would be led to introduce a circuit with a known problem (digital delay) to compensate for the newly created problem. Applicant submits that the skilled artisan would not be motivated to compensate for a problem that does not exist in the Chan reference. As such, Applicant respectfully submits that the Examiner has failed to provide a valid reason to combine the references and that the rejections of claims 3 and 13 are improper. Moreover, claim 3 depends from claim 1 and claim 13 depends from claim 11. As neither reference teaches that the orders of the filters differ by one, the rejection is

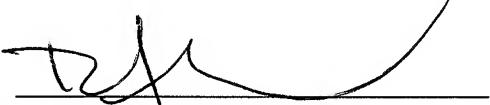
also improper for failing to show correspondence to each limitation and should be withdrawn.

In view of the remarks above, Applicant believes that each of the rejections has been overcome and the application is in condition for allowance. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is asked to contact the agent overseeing the application file, Peter Zawilski, of NXP Corporation at (408) 474-9063 (or the undersigned).

Please direct all correspondence to:

Corporate Patent Counsel
NXP Intellectual Property & Standards
1109 McKay Drive; Mail Stop SJ41
San Jose, CA 95131

CUSTOMER NO. 65913

By: 
Name: Robert J. Crawford
Reg. No.: 32,122
651-686-6633 x2300
(NXPS.276PA)